

**REMARKS**

Claims 1 through 55 are pending. Claims 33 through 36 are under examination, while the remaining claims stand withdrawn. Claims 33 and 34 have been amended herein, while claims 35 and 36 have been cancelled without prejudice to Applicants' right to pursue the cancelled subject matter in a future application claiming the benefit of priority of the above-identified application. Support for the amendments can be found throughout the application as filed, for example, at paragraph [0080]. Entry of the amendments is respectfully requested. Upon entry of the amendment, claims 33 and 34 will be pending and under examination.

**Regarding 35 U.S.C. § 112, Second Paragraph**

Applicants respectfully traverse the rejection of claims 35 and 36 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants respectfully submit that the claims are sufficiently clear and distinct to the skilled artisan to meet the requirements of 35 U.S.C. §112, second paragraph. However, this rejection has been rendered moot by the cancellation of claims 35 and 36 without prejudice. Accordingly, withdrawal of the rejection is respectfully requested.

**Regarding 35 U.S.C. § 102****Knoll et al.**

Applicants respectfully traverse the rejection of claims 33 and 35 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,014,997 to Knoll et al. The rejection is moot with regard to claim 35, which has been cancelled without prejudice.

As amended, claim 33 is directed to a kit that contains at least two polynucleotides that selectively hybridize with at least 95 percent identity to at least two of the recited CA polynucleotide sequences. It is respectfully submitted that the amendment to claim 35 obviates the rejection as evidenced by the Office's own alignment, which shows only 65.9 percent and 36.8 percent identity to SEQ ID NOS: 4 and 427, respectively. Accordingly, withdrawal of the rejection is respectfully requested.

Cargill et al.

Applicants respectfully traverse the rejection of claims 33 and 35 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2005/0026169 A1 to Cargill et al. The rejection is moot with regard to claim 35, which has been cancelled without prejudice.

As amended, claim 33 is directed to a kit that contains at least two polynucleotides that selectively hybridize with at least 95% identity to at least two of the recited CA polynucleotide sequences. It is respectfully submitted that the amendment to claim 35 obviates the rejection as evidenced by the Office's own alignment, which shows only 73 percent and 17.7 percent identity to SEQ ID NOS: 4 and 427, respectively. Accordingly, withdrawal of the rejection is respectfully requested.

Ventner et al.

Applicants respectfully traverse the rejection of claims 34 and 36 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,812,339 to Ventner et al. The rejection is moot with regard to claim 36, which has been cancelled without prejudice.

As amended, claim 34 is directed to a kit that contains at least two polynucleotides that selectively hybridize with at least 95% identity to at least two of the recited CA polynucleotide sequences. It is respectfully submitted that the amendment to claim 34 obviates the rejection with regard to SEQ ID NO: 622 as evidenced by the Office's own alignment, which shows only 32.2 percent identity to SEQ ID NOS: 622. With regard to SEQ ID NO: 53, it is respectfully submitted that the claims requires a kit at least two polynucleotides that selectively hybridize with at least 95% identity to at least two of the recited CA polynucleotide sequences. In view of Applicants' amendment herein and the accompanying remarks with regard to SEQ ID NO: 622, Ventner et al. does not disclose at least two polynucleotides that selectively hybridize with at least 95% identity to at least two of the recited CA polynucleotide sequences. In addition, while Ventner et al. appear to disclose methods and compositions relating to single nucleotide polymorphisms (SNPs) in genes that have are alleged to be involved in pathologies associated with human disease, the cited patent does not imply or disclose any association between the

disclosed SNPs and cancer. "[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added). Accordingly, withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In light of the Amendments and Remarks herein, Applicants submit that the claims are in condition for allowance and respectfully request a notice to this effect. Should the Examiner have any questions, she is invited to call the undersigned attorney.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP  
/Astrid R. Spain/  
Astrid R. Spain  
Registration No. 47,956

11682 El Camino Real, Suite 400  
San Diego, CA 92130  
Phone: 858.720.3300 ARS:cjh  
Facsimile: 858.720.7800  
**Date: June 3, 2009**

**Please recognize our Customer No. 83729  
as our correspondence address.**